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S/N 10/533150

PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	TAGUCHI, et al.	Examiner:	LEVKOVICH, NATALIA A.
Serial No.:	10/533150	Group Art Unit:	4112
Filed:	April 27, 2005	Docket No.:	10921.0315USWO
Title:	ANALYZING TOOL AND DEVICE		

CERTIFICATE UNDER 37 CFR 1.6(d):

I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on October 21, 2009.

By: 

Name: Justine Suleski

Mail Stop: PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

**PETITION AGAINST REFUSAL TO ENTER AN AMENDMENT AND
REQUEST FOR STAY OF PROSECUTION**

Dear Commissioner:

Applicants petition the refusal to enter Applicants Amendment of January 8, 2009 under 37 CFR 1.181. Applicants also petition for a stay of prosecution until a decision regarding this petition is reached.

Applicants first assert that the refusal to enter Applicants' Amendment of January 8, 2009 is improper. In particular, Applicants note that the Notice of Non-Compliant Amendment mailed on April 6, 2009 in response to Applicants' Amendment of January 8, 2009, and the Notice of Non-Compliant Amendment mailed on September 21, 2009 in response to the Response to the Notice of Non-Compliant Amendment mailed on June 8, 2009 are improper.

The January 8, 2009 Amendment amended claims 1-3, 5, 7, 8 and 10-12 and cancelled claim 4. Original filed independent claim 1 and amended independent claim 1 are both directed to an analyzing tool. Further, the amendments to claim 1, supported, for example, on page 9, lines 23-24; page 12, line 18-page 14, line 2; page 13, lines 11-22 and in Figures 2 and 4-7, did not remove any features of original claim 1, but merely further defined the invention of claim 1 by including additional structural features of the analyzing tool of original claim 1. Accordingly, originally filed claim 1 is broad enough in scope to cover the features amended into claim 1 in the January 8, 2009 Amendment. No election of species was required among the embodiments encompassed by original claim 1.

Application Serial No: 10/533,150

The April 6, 2009 Notice asserts that claims 1-3 and 5-12 as presented in the Amendment of January 8, 2009 are directed to an invention that is independent or distinct from the invention of the original claims 1-12, and that the invention of original claims 1-12 have been constructively elected by original presentation for prosecution on the merits. However, original claim 1 is generic to the amended claim 1, as noted above. Therefore, original claim 1 and amended claim 1 cannot reflect independent and distinct inventions for purposes of a restriction requirement.

In a telephonic interview on April 17, 2009 between the Examiner and Applicants' Representative, the Examiner also noted that under 37 CFR 1.142(b) and in light of MPEP 821.03, the constructive election of species of original claims 1-12 is proper.

However, 37 CFR 1.142(b) and MPEP 821.03 are directed to a requirement for restriction of two or more independent and distinct inventions and not to a requirement for an election of species, governed under 37 CFR. 1.146.

Accordingly, since original claims 1-12 were examined without requiring Applicants to elect a species in the Office Action on the merits mailed on July 8, 2008, the Examiner's constructive election of claims 1-12 is improper.

The September 21, 2009 Notice asserts that since the original claims were directed to a single species, "there were no grounds for restriction". However, the issue in question is an election of species issue, which is based on the disclosure rather than the claims (see MPEP 806.04), and not a restriction.

The September 21, 2009 Notice also asserts that the removal of Species I from the claims in favor of Species II constitutes a shift of the invention originally claimed. However, Applicants again note that original claim 1 is broad enough to cover Species I and Species II and no election of species was made in or prior to the Office Action on the merits mailed on July 8, 2008.

Accordingly, Applicants respectfully request entrance and proper examination of the Amendment of January 8, 2009 and withdrawal of the Notices of Non-Compliant Amendment mailed on April 6, 2009 and September 21, 2009.

Applicants also respectfully request a stay of prosecution until a decision regarding this petition is reached. In particular, Applicants respectfully assert that there would be no point in proceeding with prosecution until a decision regarding this petition is reached, as Applicants have asserted that a proper Amendment was filed on January 8, 2009.

Application Serial No: 10/533,150

Please charge any additional fees or credit overpayment to Deposit Account No. 50-3478.



Dated: October 21, 2009

Respectfully submitted,

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